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Frank Muir

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WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

DANIELS, MATTHEW J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/807,411
Filing Date: March 24, 2004
Appellant(s): MUIR, FRANK

MAILED
JUL 23 2007
GROUP 1700

Michael E. Whitham
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 April 2007 appealing from the Office action
mailed 8 June 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. The claims are mapped to the specification beginning on page 8 of the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

2,635,289	OWENS	04-1953
4,401,434	HARRIS	08-1983
2,669,369	TOWNS	02-1954

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-3, 7, 8, 9, 10, 11, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289).

The Examiner submits that Owens' annular shape is suitable for engaging a bottle, and therefore meets all intended use limitations drawn to engaging of bottles or serving as a bottle cap. As to Claim 1, Owens teaches: A method of making a bottle cap with a built-in magnification feature (Figs. 20-30), comprising the steps of selecting a radius of curvature (inherent in that a radius is provided), pressing a single piece of plastic (Figs. 62, 63, see "a plastic sheet" at 3:26) into the shape of a bottle cap having a top portion (Fig. 30, Items 284,281) and an annular bottle engaging portion (Fig. 30, Items 286,285) which includes thread engaging members for selectively affixing the bottle cap to a top of a bottle, wherein said at least one of said upper or lower convex surfaces of each bottle cap has a radius of curvature (many of the elements of Owens would have a radius so as to magnify, see the figures) so as to provide optical magnification of objects through said top portion.

Although Owens does not explicitly disclose different radiuses (radii) being selected, Owens clearly instructs the ordinary artisan to provide a “size and shape wanted in the finished element” at 32:30-31. However, the step of selecting a radius of curvature is implicit and the intention of producing multiple parts having multiple shapes provides no material limitation to the method of making because it is the same method that would be practiced in each case. Additionally, Owens clearly suggests that one select the size and shape of the article to be produced, and varying the size and shape in the manner suggested by Owens reads on the claimed invention. **As to Claim 2**, Owens teaches the pressing step is achieved using a stamping machine (Figs. 1 and 2). **As to Claim 3**, Owens teaches the annular bottle engaging portion includes thread engaging members (Fig. 30). **As to Claim 7**, by the multitude of elements shown in the figures of Owens, it is asserted that Owens clearly recognizes the particular radii of curvature to be a result-effective variable which can be modified and optimized. Additionally, Owens teaches that the upper and lower surfaces are convex and have an equal radius of curvature (Figs. 25 and 40, for instance). **As to Claim 9**, Owens teaches a flat surface and a convex surface (Fig. 20). Although silent to the top and bottom surfaces, this is a matter of orientation, and Owens’ Fig. 20 meets the claimed limitation. **As to Claims 10 and 11**, Owens teaches plastic as an optical lens, which would have inherently have been transparent and translucent (Title, 4:14, 11:69-12:33). These terms appear to overlap in scope. **As to Claim 18**, Owens’ process is simultaneous, and forms one or two convex surfaces (see the figures).

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Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289) in view of Towns (USPN 2669369). Owens teaches the subject matter of Claim 1 above under 35 USC 103(a).

As to **Claim 4**, Owens teaches compression molding, but is silent to a bottle-engaging portion that includes a lid wall with an inwardly projecting hook region at its base. However, this aspect is taught by Towns (Figs. 1-6). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Towns into that of Owens because a) Owens suggests that a means for fixedly mounting the lens be provided (20:46-48) and Towns provides means for fixedly mounting (Fig. 3), and b) Towns suggests compression molding (2:9), which Owens provides (entire document).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289) in view of Harris (USPN 4401434). Owens teaches the subject matter of Claim 1 above under 35 USC 103(a).

As to **Claim 17**, Owens appear to be silent to the particular configuration, however, the Examiner takes the following positions: Firstly, the Examiner asserts that this limitation is drawn to the particular size and shape, which do not materially affect the method. Secondly, the Examiner asserts that Harris provides a lens having convex surfaces and a perimeter which extends to an edge of the annular bottle engaging portion (Fig. 5, items 64, 28, and 12). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Harris into that of Owens in order to provide a kit which is easy to manufacture and market (2:12-14), adapted for easy storage and maintenance of all the

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components needed in a single location (2:1-11), maintaining the viewer in a convenient position (2:29-40), and providing the largest possible magnifier in the lid to maximize the effect of the invention.

(10) Response to Argument

Appellant argues on pages 15-16 that Owens has nothing to do with bottle caps.

Appellant argues on pages 16-17 that there is no discussion in Owens of selecting a radius of curvature for the upper or lower convex surfaces of a top portion of each cap wherein different radiuses are selected for different diameter bottle caps. Appellant argues on page 17 that Owens provides one lens with one radius for one instrument which would not allow the mass production of anything similar to bottle caps. Appellant further argues on page 17 that the step of selecting a radius of curvature for different diameter bottle caps simply would not be obvious.

Firstly, Owens provides teaching and suggestion to select a particular size and shape according to that which is wanted in the finished element (32:30-31). Additionally, Owens teaches that different optical devices may be made, such as camera lenses, telescopes, and ophthalmic lenses (5:27, 6:23, 6:31), and the Examiner asserts that the ordinary artisan would find it prima facie obvious to make these lenses of different sizes, according to that which is wanted in the finished element. It is well known that the radius or radii of curvature of a lens affects the magnification power of a lens, and selection of various radii for use with camera lenses, telescopes, and ophthalmic lenses would have been obvious to the ordinary artisan consistent with the method of Owens.

Secondly, changes in size and shape are generally insufficient to patentably distinguish a claimed invention. See, for example, *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.). Also see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). Also see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Here the claimed invention is a method of making multiple parts, each having different sizes without a change in the function of the resulting article. However, cases such as *Rinehard*, *Gardner*, and *Dailey* support the Examiner’s position that the changing of size and shape is generally prima facie obvious.

Appellant argues on page 17 that Owens does not provide simultaneous pressing of the annular portion and the top portion.

The Examiner respectfully disagrees with this interpretation. Figures 29 and 30 show a lens with attached threads without division between the thread portions and the lens. Col. 20, lines 14-19 recite that “A light-transmitting element 271 is formed as a part of a cylinder generally indicated as 272 which has a backwardly extending flange 273 and a forwardly extending and off-set portion 274 embodying an external thread 275” (emphasis added). Also note Column 3, lines 31-50, and in particular the portion beginning at line 20 which states “Thus by one operation I am able to create both an optical element and the means for protecting, positioning, mounting and operating it.” The means for positioning and mounting includes threads (3:43). It is submitted that the threads and lens are simultaneously pressed in “one

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operation” in order that the lens is formed “as a part” of the cylinder as a means for mounting and positioning.

Appellant argues on page 17 that the materials are transparent, but Owens “at no point shows or suggests a translucent material.”

It should be noted that Appellant advanced a dictionary definition of “translucent” on page 10 of remarks filed 17 March 2006. It should further be noted that at least one supplied definition of “translucent” encompasses “transparent”. See definition 2 under “translucent” (left column). Therefore, it was concluded that, consistent with a dictionary definition supplied by Appellant, “transparent” falls within the broadest reasonable interpretation of “translucent”. Because the optical articles of Owen are transparent in order to function as lenses, and because translucent lenses include transparent lenses, Claim 11 would have been obvious as set forth in the rejection.

With regard to the rejection of Claim 4, Appellant argues on page 17 that Owens cannot be properly combined with Towns as suggested by the Examiner. Appellant further argues on pages 17-18 that Towns does not show a magnifying lens, and is concerned with eliminating the dissipation of carbonation. Appellant further argues on page 18 that there is no motivation to combine the optics of Owens and the re-sealing features of Towns.

It has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed

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invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Towns teaches a compression molding process (2:9) for forming a bottle cap (title), and therefore it is submitted that the Towns reference is at least within the field of Applicant's endeavor.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, Appellant does not appear to dispute that Towns provides the claimed element of Claim 4.

Appellant's arguments do not appear to address the motivation set forth in the rejection, and therefore it is still believed to be valid. Owens explicitly suggests that a means for mounting should be provided (3:20-50) in a compression molding process, and Towns provides a means for mounting formed by a compression molding process.

With regard to the rejection of Claim 17, Appellant argues on page 18 that Harris discloses a lens and cap that are separate. Appellant further argues that the invention requires that the lens is part of a single piece of plastic, and therefore that Harris teaches away from the claimed invention.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Owens provides a lens and mounting means that are integral.

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With regard to Appellant's assertion that Harris teaches away from the claimed invention, Harris provides a magnifying or like viewing glass (1:63) in a cap, and does not appear to require that the lens and cap be separate or separable. The cap (2:30-35, 4:35-53) and lens (4:52-53) may be each made from plastic, and because it is generally considered to be prima facie obvious to make separate portions integral, it is submitted that there is no teaching away from the claimed invention. Harris discloses that threads may be incorporated on the cap as an alternative to a light press fit relation (4:26-34).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Matthew J. Daniels



Conferees:

Christina Johnson



Chris Fiorilla

